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09/553,011	04/20/2000	Paul Entwistle	00164	4311

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EXAMINER

BOWES, SARA E

ART UNIT	PAPER NUMBER
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2171

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DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,011

Applicant(s)

ENTWISTLE, PAUL

Examiner

Sara Bowes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/20/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims 1-8 and 10-12 are pending.

Claim 9 has been canceled.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not identify the citizenship of each inventor.

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

The full name of each inventor (family name and at least one given name together with any initial) has not been set forth.

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Specification

The disclosure is objected to because of the following informalities: misuse of the word "dame," page 1, line 11. The common definition of dame as defined by Webster's Dictionary is "a woman" so being unrelated to the discussion.

The specification is objected to as being written in non-U.S. English, for example, claim 2, line 4, "unauthorised". The applicant is respectfully requested to amend such occurrences into U.S. English so as to allow for text searching when the application matures into a patent.

Appropriate correction is required.

Claim Objections

Claim 8 is objected to because of the following informalities: the word "displays" should be changed to its singular form.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims 1-5 and 10-12, the specification does not provide support for the amended claims. The amended claims recite a method whereas the specification recites a system for receiving broadcast program material.

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 8, and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 1, this claim is rejected as failing to recite active method steps. Further more claim1 is rejected because the phrase "if" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Referring to claims 2-5 and 10-12, these claims are also rejected because they are dependent on claim 1 and therefore inherit its deficiencies.

Claim 3 recite the limitation "a descrambled form" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. A descrambled form is not discussed in claim 1.

Claim 4 recite the limitation "the processing step of descrambling" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim. A descrambling process is not discussed in claim 1.

Referring to claim 8, this claim is ambiguous. The examiner is unclear as to what the applicant regards as his invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,619,571 to Sandstrom et al. in view of U.S. Patent No. 5,805,706 to Davis.

Referring to claim 1, Sandstrom et al. teach a method that employs a broadcast data receiver that identifies and stores broadcast program material in a memory and

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allows subsequent selected retrieval of material from the memory [see column 2, lines 65-67], comprising the steps of:

receiving the broadcast program material [column 5, lines 24-27] and processing the material to generate a number of location identifiers [Pointer, Figure 2, 66] for respective portions of the material, which identifiers are held in a database for reference; and upon selection of identifiers, retrieval of respective portions of material from said memory [column 5, lines 43-44].

Sandstrom et al do not explicitly teach receiving broadcast material in an encrypted format.

However, Davis disclose receiving material in an encrypted format.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the cryptographic device of Davis to the system and method of Sandstrom et al., such that Sandstrom et al's system would include the cryptographic device within the processing unit to receive broadcast material in an encrypted format. One would have been motivated to modify Sandstrom et al.'s method as such in order to provide the broadcast material with a higher level of security when being transmitted over insecure communication lines.

Referring to claim 2, Sandstrom et al. as modified teach a method according to claim 1 wherein the encrypted material undergoes a further processing step of copy protection so that when said material is stored in said memory it is protected against unauthorized copying [see column, 4, lines 45-48]

Referring to claim 3, Sandstrom et al. as modified teach a method according to claim 1 wherein the processing step for the encrypted material is performed as one process so as to prevent unauthorized access to the material when in a de-scrambled form [see Figure 2a and column 2, lines 64-67 of Davis].

Referring to claim 4, Sandstrom et al. as modified teach a method according to claim 1 wherein if said broadcast program material received is not encrypted, it is received and identified for storage in a memory but need not pass through at least the processing step of de-scrambling memory [see column 2, lines 65-67].

Referring to claim 5, Sandstrom et al teach a method according to claim 1 wherein the database of location identifiers which is generated in relation to the encrypted material is also encrypted to ensure security of the material [see column 5, lines 43-50].

Referring to claim 6, Sandstrom et al. teach a method of generating a database index of the location of specified features of video and/or audio data material relating to a broadcast program held in a memory device [see Figure 2, IMAGE FILE DIRECTORY, 54], said material received by a broadcast data receiver from a remote location [see Figure 1, remote computer, 40] and wherein the method comprises the steps of:

parsing the data to generate a plurality of location identifiers for respective portions of the material [see Figure 2, Segment, 68 and Pointer, 66]; storing the said location identifiers in a database [see column 5, lines 43-44]; and locally encrypting said material prior to storage in said memory device [see column 6, lines 64-67].

Sandstrom et al. do not teach a method of receiving said material by a broadcast in an encrypted and so also do not teach decrypting the data.

However, Davis does disclose a method of receiving said material by a broadcast in an encrypted and so also discloses decrypting the data [see Figure 2a].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the cryptographic device of Davis to the system and method of Sandstrom et al., such that Sandstrom et al.'s system would include the cryptographic device within the processing unit to receive broadcast material in an encrypted format and then decrypt the received data. One would have been motivated to modify Sandstrom et al.'s method as such in order to provide the broadcast material with a higher level of security during transmission over insecure lines and the ability to decrypt the data so that the processing unit can manipulate the data as it sees fit.

Referring to claim 7, Sandstrom et al as modified teach a method according to claim 6 wherein the memory device and a processing apparatus for performing the method are located in said broadcast data receiver [see Figure 1, 22 and column 3, lines 1-4 and 10].

In light of the specification claim 8 is rejected over Sandstrom et al. as modified. Sandstrom et al. as modified teach a method according to claim 7 wherein the program material received is in an encoded digital format and said broadcast data includes a system for decoding the received data [see Figure 2a of Davis] including the step of generating an audio display via a speaker or speakers [column 8, line 3-4].

One of ordinary skill would understand that the computer 10 of Sandstrom et al. includes speaker or speakers to allow for an alarm to sound [column 8, lines 3-4].

Referring to claim 10, Sandstrom et al as modified teach a method according to claim 1 in which said step of processing said material to generate a number of location identifiers includes de-scrambling the material [see Figure 2a and column 2, lines 64-67 of Davis].

Referring to claim 11, Sandstrom et al. as modified teach a method according to claim 1 in which said step of processing said material to generate a number of location identifiers includes decrypting the material [see Figure 2a and column 2, lines 64-67 of Davis].

Referring to claim 12, Sandstrom et al. as modified teach a method according to claim 1 in which said step of processing said material to generate a number of location identifiers [Pointer, 66, column 5, lines 43-44] includes data stream parsing the material [see Figure 2, Segment, 68].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,046,090 to Walker et al.

U.S. Patent No. 5,838,668 to Okada et al.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Bowes whose telephone number is 703-305-0326. The examiner can normally be reached on 7:30-4:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

seb
10/7/03


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